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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,840	01/21/2004	Ronald B. Odlich	J53-014 US	3068
21706	7590	04/05/2006	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			HOFFMAN, MARY C	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/761,840	ODRICH, RONALD B.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mary Hoffman	3733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 9-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I, Species A and Subspecies II, claims 1-3 and 5-8, in the reply filed on 03/09/2006 is acknowledged.

Claims 4 and 9-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 03/09/2006.

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

The drawings are objected to because of the informalities listed on the attached PTO-948. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993)\*, *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)\*, *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982), *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)\*, and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 5-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 16 of copending Application No. 10/935413. Although the conflicting claims are not identical, they are not patentably distinct from each other because they encompass essentially the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson (U.S. Patent No. 3,514,859).

Peterson discloses a periosteal distraction osteogenesis method comprising applying to a surface of living bone that is covered by soft tissue, a sheet member (see FIG. 1, ref. #1 and 2) for covering at least a portion of the bone surface under the soft tissue, at which bone growth that is outward and normal to the bone surface is desired, securing an attractor member (ref. #17) at an outwardly spaced location from the portion of the bone surface at which the bone growth is desired, and magnetically attracting the sheet member and the attractor member to each other for applying a

pulling force on the sheet member that is away from the portion of the bone surface at which bone growth is desired for causing growth of bone outwardly and normally to the bone surface. The sheet member is a sheet of magnetically attractable material and the attractor member is a permanent magnet. The sheet member is a sheet of magnetically attractable mesh material and the attractor member is a permanent magnet. The sheet member is a sheet of magnetically attractable material having an increased attraction characteristic at said portion of the bone surface and less attraction characteristic around said portion of the bone surface.

Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Linkow (U.S. Patent No. 4,702,697).

Linkow discloses a periosteal distraction osteogenesis method comprising applying to a surface of living bone that is covered by soft tissue, a sheet member (ref. #50) for covering at least a portion of the bone surface under the soft tissue, at which bone growth that is outward and normal to the bone surface is desired, securing an attractor member (magnetic material on bridge, see col. 6, lines 30-60) at an outwardly spaced location from the portion of the bone surface at which the bone growth is desired, and magnetically attracting the sheet member and the attractor member to each other for applying a pulling force on the sheet member that is away from the portion of the bone surface at which bone growth is desired for causing growth of bone outwardly and normally to the bone surface. The sheet member is a sheet of magnetically attractable material and the attractor member is a permanent magnet (col. 6, lines 30-60). The sheet member is a sheet of magnetically attractable mesh material

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and the attractor member is a permanent magnet. The sheet member is a sheet of magnetically attractable material and the attractor member is a permanent magnet, said portion of the bone comprising an edentulous area of a jawbone crest, the method including wrapping the edentulous area of the jawbone crest with the sheet member and securing the attractor member to at least one tooth that is adjacent the edentulous area of the jawbone crest. The sheet member is a sheet of saddle shaped magnetically attractable mesh material and the attractor member is a permanent magnet, said portion of the bone comprising an edentulous area of a jawbone crest, the method including wrapping the edentulous area of the jawbone crest with the sheet member and securing the attractor member to at least one tooth that is adjacent the edentulous area of a jawbone crest. The sheet member is a sheet of magnetically attractable material and the attractor member is a permanent magnet, said portion of the bone comprising an edentulous area of a jawbone crest, the method including wrapping the edentulous area of the jawbone crest with the sheet member and securing the attractor member across two tooth that are on opposite sides of the edentulous area of the jawbone crest, outwardly of the soft tissue which comprises gingival tissue over the edentulous area.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Fromovich (U.S. Patent Application Publication 2003/0104339).

Fromovich et al. discloses embodiments of periosteal distraction osteogenesis method (see FIG. 7, also page 13, col. 1 and 2) comprising applying to a surface of living bone that is covered by soft tissue, a sheet member (ref. #115) for covering at least a portion of the bone surface under the soft tissue, at which bone growth that is outward and normal to the bone surface is desired, securing an attractor member (ref. #118) at an outwardly spaced location from the portion of the bone surface at which the bone growth is desired, and magnetically attracting the sheet member and the attractor member to each other for applying a pulling force on the sheet member that is away from the portion of the bone surface at which bone growth is desired for causing growth of bone outwardly and normally to the bone surface. The sheet member is a sheet of magnetically attractable material and the attractor member is a permanent magnet. The sheet member is a sheet of magnetically attractable mesh material and the attractor member is a permanent magnet (page 13, lines 1-14). The sheet member is a sheet of magnetically attractable material and the attractor member is a permanent magnet, said portion of the bone comprising an edentulous area of a jawbone crest, the method including wrapping the edentulous area of the jawbone crest with the sheet member and securing the attractor member to at least one tooth that is adjacent the edentulous area of the jawbone crest. The sheet member is a sheet of saddle shaped magnetically attractable mesh material and the attractor member is a permanent magnet, said portion of the bone comprising an edentulous area of a jawbone crest, the method including wrapping the edentulous area of the jawbone crest with the sheet member and securing the attractor member to at least one tooth that is adjacent the edentulous area of a



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jawbone crest. The sheet member is a sheet of magnetically attractable material and the attractor member is a permanent magnet, said portion of the bone comprising an edentulous area of a jawbone crest, the method including wrapping the edentulous area of the jawbone crest with the sheet member and securing the attractor member across two tooth that are on opposite sides of the edentulous area of the jawbone crest, outwardly of the soft tissue which comprises gingival tissue over the edentulous area.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Form PTO-892.


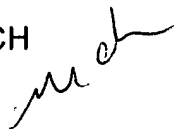
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCH



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER